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The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 Ex parte TORU SORIHASHI
11

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13 Appeal 2008-1687
14 Application 09/757,726
15 Technology Center 2100
16

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18 Oral Hearing Held: July 9, 2008
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22 Before JAMES D. THOMAS, ST. JOHN COURTENAY III, and THU
23 ANN DANG, Administrative Patent Judges
24

25 ON BEHALF OF THE APPELLANT:
26

27 STEVE JENSEN, ESQUIRE
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32 The above-entitled matter came on for hearing on Wednesday, July 9,
33 2008, commencing at 9:00 a.m., at The U.S. Patent and Trademark Office,
34 600 Dulany Street, Alexandria, Virginia before Dominico Quattrociocchi,
35 Notary Public.
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37

1 MS. HALL: -- 2008-1687, and the attorney is Mr. Steve Jensen.

2 JUDGE THOMAS: Good morning, sir.

3 MR. JENSEN: Good morning.

4 JUDGE THOMAS: Do you -- have you been to the Board before?

5 MR. JENSEN: A while ago.

6 JUDGE THOMAS: Okay. Just remember you can use the clock as a
7 guide for your 20 minutes of time to argue.

8 MR. JENSEN: Okay.

9 JUDGE THOMAS: And you are free to proceed at any time.

10 MR. JENSEN: Okay. Thanks. Okay. Good morning. May it please
11 the Board, my name is Steve Jensen. I'm counsel for appellant and the real
12 party in interest, Sharp Corporation. My objective today is to highlight
13 some differences between the cited combination of references and the
14 subject invention, which we believe is at the crux of the issue of
15 patentability of the invention on appeal. Specifically, I want to focus on the
16 log recording/reproducing section of the information processing device as
17 recited in independent claim 1. And similar limitations are also present in
18 independent claims 20 and 23. We believe that this limitation in the claim's
19 overall patentability distinguish over the proposed combination of the
20 Eintracht in view of Ichiriki references.

21 In my presentation, I would like to address three issues that have been
22 outlined in the appeal brief and the reply brief. First, that the combination of
23 Eintracht in view of Ichiriki does not teach or suggest a log
24 recording/reproducing section that creates log data of operations executed by
25 a data creating section and a data reference section when creating a data file.
26 Second, that Eintracht in view of Ichiriki does not teach or suggest a log

1 recording/reproducing section that controls a data creating section and a data
2 reference section to re-execute operations that are stored in the log data.
3 And third, even if the proposed combination of Eintracht in view of Ichiriki
4 was made, this combination would not result in the appellant's claimed
5 invention.

6 Let me just begin, then, by describing the invention, and I'll just call
7 your attention to claim 1 of the claims appendix of the appeal brief. The
8 subject invention is an information processing device such as a personal
9 computer for creating and displaying a data file. The device includes three
10 major components, which are outlined in the claim. A data creating section
11 for creating the data file; this could be a word processor. It's exemplified by
12 a document management system, document editing section 32 in Figure 1.
13 The second major component is a data reference section, which is used for
14 displaying reference data. Basically, this is anything that the user wishes to
15 refer to in the data file. This is exemplified by reference nos. 33 through 37
16 in Figure 1. And third, a log recording/reproducing section, and this is
17 exemplified by reference no. 31 in Figure 1, and this has a couple of
18 different functions. One is to create log data, including history data of
19 operations that are executed by both the data creating section and the data
20 reference section when creating the data file. And second, the second
21 function is that it controls the data creating section and the data reference
22 section to re-execute operations that are stored in the logged data, which
23 allows the user to reproduce and display the data file.

24 As a result of these -- this combination of different components, the
25 user is able to see any materials that were referred to during the creation of
26 the data file. And because the log recording/reproducing section stores log

1 data of all operations that are executed by the data creating section and the
2 data reference section, it's possible to re-execute these operations and, thus,
3 reproduce the data file.

4 Now I just want to address the references, and then I'll just go into the
5 arguments after that.

6 JUDGE THOMAS: We have an understanding of the references.

7 MR. JENSEN: Sure. Okay.

8 JUDGE THOMAS: And a good understanding of your arguments as
9 presented in the briefing.

10 MR. JENSEN: Okay.

11 JUDGE THOMAS: So it would be helpful, perhaps, just to make
12 your focus points here now, if you could.

13 MR. JENSEN: Sure. Sure. Okay, I'll skip the discussion on the
14 references and I'll just go right to the arguments, then. Just --

15 JUDGE THOMAS: By the way, do you argue that the references are
16 not combinable in the -- as the Examiner has asserted?

17 MR. JENSEN: I would assert that if there was a combination that the
18 Examiner was asserting, if that combination was made, it would not result in
19 the claimed invention.

20 JUDGE THOMAS: That's your bottom line, right?

21 MR. JENSEN: Right.

22 JUDGE THOMAS: So -- okay. What types of data would be stored
23 in that combination, in your view?

24 MR. JENSEN: I don't see how the combination would -- could
25 possibly be made, because the Eintracht reference is directed to producing --
26 or preparing notes based on an existing document. So annotations are made

1 by the user, these are put into the client server on the client's side, and then
2 those are eventually synchronized with the Web server, with the notes
3 database on the Web server, which is on the server side.

4 The Ichiriki reference really is different in that there is some data --
5 there's a data creating -- or there's the ability to create a data file, and there's
6 also the ability to create reference information. But how that would be
7 combined with the Eintracht references is unclear. Because there'd be no
8 reason to include a reference data section in the Eintracht reference, because
9 there's already a way to create notes and there would be no reason to create
10 additional reference information. So I don't think that the combination
11 makes a lot of sense.

12 And even if you -- even considering the teaching, suggestion,
13 motivation rationale that the Examiner used, the Examiner had stated
14 previously, in the -- section, that it would be inherent to have a data creating
15 section in the Eintracht reference, then he goes ahead and says, for the
16 combination, that it would be obvious to include the data creating section as
17 provided in Ichiriki, and also to include a data reference section of Ichiriki.
18 However, this doesn't make a lot of sense because if it's already inherent in
19 Eintracht, there'd be no reason to combine Ichiriki reference with Eintracht.

20 So just going back to the three primary arguments that I would like to
21 make, and these are just the same as the arguments that are outlined in the
22 appeal brief and the reply brief, there is no teaching or suggestion in
23 Eintracht in view of Ichiriki of a log recording/reproducing section that
24 creates log data, including history data of operations executed by a data
25 creating section and a data reference section.

26 JUDGE THOMAS: We understand your positions in the brief.

1 MR. JENSEN: Okay. I guess the crux of the argument there is that
2 the Examiner is saying that the notes or annotations are considered log data.
3 Even if that's the case, even if we assume that the notes or annotations in
4 Eintracht are considered log data, they are still not history data of operations
5 executed by a data creating section and a data reference section. They're
6 simply user-generated notes, and these notes are combined together using
7 the synchronization means in the Eintracht reference, and so, basically,
8 they're consolidated, all the notes are consolidated for a particular document,
9 kept together. But these do not reflect -- the notes in Eintracht do not reflect
10 history data of operations that were executed by the data creating section and
11 data reference section. I don't think notes can be considered operations.

12 JUDGE COURTENAY: Yes, but your claim recites creating log data,
13 including history data of operations. It doesn't preclude other types of data
14 from being included in the log data.

15 MR. JENSEN: That's right. That's why I say I think, you know,
16 arguably, they could be considered log data, but they're not history data of
17 operations executed by a data creating section and a data reference section.
18 And so, that part is -- that part of the claim is missing in the proposed
19 combination.

20 And again, the claim does recite that the log data includes history data
21 of operations that are executed by both a data creating section and a data
22 reference section. And the Examiner has already said that Eintracht
23 inherently discloses a data creating section, and then he goes to the
24 secondary reference, Ichiriki, for both a data creating section and a data
25 reference section. But kind of as I pointed out at the beginning, it doesn't
26 make a lot of sense to include a data reference section in the Eintracht

1 reference. There'd be no purpose for including a data reference section
2 because the whole point of the Eintracht reference is that you create notes
3 based on existing documents. So if the notes are the log data and those are
4 generated by the data creating section, assuming one is inherently present,
5 there would be no reason to include a separate data reference section in
6 Eintracht.

7 And that's basically the crux of the first argument. The second
8 argument is that the combination of Eintracht in view of Ichiriki does not
9 teach or suggest a log recording/reproducing section that controls a data
10 creating section and a data reference section to re-execute operations stored
11 in the log data. There is just simply no teaching or suggestion of re-
12 executing any operations that are stored in the log data. Even if we consider
13 the notes log data, there's no operations involved with the notes. They're just
14 text files. There's nothing to re-execute. Whereas in the claimed invention,
15 what we have is a data creating section, a data reference section, which have
16 different contributions to the data file, and when you re-execute those
17 operations, which involve word processing functions, for example, or
18 drawing data or other types of reference data, you re-execute that
19 information, you're able to recreate the data file. You're not able to do that
20 in the combination of Eintracht in view of Ichiriki.

21 And the third argument is just that the combination -- and this just
22 goes back to what I was saying in response to your question, which is that
23 the combination would not result in the claimed invention. Again, the
24 Examiner has stated that the data creating section is inherently present, and
25 then he goes ahead and cites the Ichiriki reference as a secondary reference,
26 saying that, oh, there's also a data creating section in the Ichiriki reference,

1 there's a data reference section in Ichiriki reference. But the point I want to
2 make here is just that it doesn't make sense to include a data reference
3 section with Eintracht because there would be no additional functionality
4 that would be provided by such a combination. The notes in Eintracht, if we
5 consider those part of the data creating section, there's nothing else to be
6 included. There's nothing to be added by a data reference section.

7 I think that pretty much summarizes it. Are there any other questions?

8 JUDGE COURTENAY: No questions.

9 JUDGE THOMAS: No questions, I guess, so --

10 MR. JENSEN: Okay.

11 JUDGE THOMAS: -- thank you very much.

12 MR. JENSEN: Okay. Thank you.

13 REPORTER: Excuse me, sir, I just need to get the spelling of your
14 last name, please.

15 MR. JENSEN: It's J-e-n-s-e-n.

16 REPORTER: And I guess what's the -- Ichiriki?

17 MR. JENSEN: Yeah, it's I-c-h --

18 REPORTER: I-c-h --

19 MR. JENSEN: -- i-r --

20 REPORTER: -- i-r --

21 MR. JENSEN: -- i-k-i.

22 REPORTER: -- i-k-i.

23 MR. JENSEN: Yes.

24 REPORTER: And the other one was -- what was the --

25 MR. JENSEN: Eintracht. It's E-i-n-t-r-a-c-h-t.

26 REPORTER: Okay. Thank you.

1 MR. JENSEN: Thanks. Thanks a lot. Have a good day.

2 JUDGE COURTENAY: You too.

3 (Whereupon, the proceedings concluded on July 9, 2008, at

4 9:52 a.m.).